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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/582,729	08/16/2006	Henning Schulte	SCHULTE ET AL-4 PCT	4664
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COLLARD & ROE, P.C. 1077 NORTHERN BOULEVARD ROSLYN, NY 11576			EXAMINER VORTMAN, ANATOLY	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/582,729	Applicant(s) SCHULTE ET AL.	
	Examiner ANATOLY VORTMAN	Art Unit 2835	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) 2-5 and 7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Reply Under 37 CFR 1.111

1. The submission of the reply filed on 10/17/08 is acknowledged. Claims 2- 4 have been amended and new claims 6 -7 have been added. Thus, claims 1-7 are pending in the instant application. The Office action follows:

Election/Restrictions

2. Amended claims 2-5 and 7, are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

The original claims 1-5 have been drawn to an apparatus (one-piece fuse insert), classified in class 337. The amended claims 2-5 and 7, are directed to a method (for producing a one-piece fuse insert), classified in class 29, subclass 623.

The aforementioned inventions are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the process as claimed can be used for making any metal article comprising an area of the reduced thickness. Further, the product as claimed (fuse insert) can be made by another and materially different process, for example substituting the step of pressing with the step of

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milling, cutting, shaving, or any another similar step for producing an area of the reduced thickness.

Since Applicant has received an action on the merits for the originally presented invention of an apparatus (one piece fuse insert), this invention has been **constructively elected by original presentation** for prosecution on the merits. Accordingly, claims 2-5, and 7 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03. The Office action on the elected apparatus claims 1 and 6 follows:

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by US/4,023,265 to Aryamane.

Regarding claim 1, Aryamane disclosed (Fig. 1-4, 8, and 9) a one-piece fuse insert (4) consisting of a flat part punched from sheet metal, particularly zinc sheet metal (col. 5, line 66) particularly a flat plug, the contacts (8) of which are connected with one another by means of a connection piece (20, 22) that forms a fusible conductor, wherein at least one segment (20) of the connection piece is formed flat in such a manner that its thickness is reduced by a predetermined

dimension as compared with the original thickness of the sheet metal. Further, regarding the method/process of making limitation “pressed”, please note that, even though the claim is limited by and defined by the recited process, the determination of patentability of the product is based on the product itself, and does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). It is the patentability of the product claimed and not of the recited process steps which must be established. *In re Brown*, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972). It should also be noted that a “[p]roduct-by process claim, although reciting subject matter of claim in terms of how it is made, is still product claim; it is patentability of product claimed and not recited process steps that must be established, in spite of fact that claim may recite only process limitations”, *In re Hirao and Sato*, 190 USPQ 15 (Fed. Cir. 1976). Therefore, the limitation has not been given patentable weight.

Further, regarding claims 2-5, the claims are the product-by-process claims and directed strictly to the method/process of making the aforementioned fuse insert. Therefore, the claims have not been given patentable weight. See *In re Thorpe*, *In re Brown*, and *In re Hirao and Sato*, *supra*.

5. Alternatively, claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by US/6,642,834 to Oh et al (Oh).

Regarding claim 1, Oh disclosed (Fig. 1 and 4-8) a one-piece fuse insert (12, 30, 32, 34, 54) consisting of a flat part punched from sheet metal, particularly zinc sheet metal (col. 3, line 10) particularly a flat plug, the contacts (38, 40; 50, 52; 44, 46; 58, 60) of which are connected

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with one another by means of a connection piece (22, 36, 42, 48, 56) that forms a fusible conductor, wherein at least one segment of the connection piece is pressed flat (col. 2, lines 6-8) in such a manner that its thickness is reduced by a predetermined dimension as compared with the original thickness of the sheet metal.

6. Claim 6, and yet alternatively claim 1, are rejected under 35 U.S.C. 102(a) as being clearly anticipated by the Applicant's Admitted Prior Art (AAPA).

Regarding claims 1 and 7, AAPA teaches that it was known at the time of the invention to form a one-piece fuse inserts as claimed (see, instant specification, p.1, line 15 to p. 3, line 9), including that said fuse inserts being tin or silver coated for protection (p. 4. lines 1-4).

Further, regarding the method/process limitation "pressed" of claim 1 and regarding the method/process limitations of the product-by-process claims 2-5, the recited method/process limitations have not been given patentable weight. See *In re Thorpe*, *In re Brown*, and *In re Hirao and Sato, supra*.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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8. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Aryamane or Oh, each taken alone, or in the alternative, taken with AAPA.

Regarding claim 6, Aryamane and Oh, each disclosed all as applied to claim 1, and Oh further disclosed that the one-piece fuse insert is formed from a *coated zinc* (col. 3, lines 8-10), but did not specify that said coating is made of tin or silver. It would have been obvious to a person of the ordinary skill in the fuse art at the time of the invention to use such a well known materials as tin or silver for making said coating, in order to achieve the most sufficient protection, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. Alternatively, AAPA teaches that it was known at the time of the invention to form a one-piece fuse inserts being coated with tin or silver for protection (see from the end of p. 3 to p. 4. line 4).

Therefore, it would have been obvious to a person of the ordinary skill in the fuse art at the time of the invention to use a well known technique of making tin or silver coating, as taught by AAPA, in order to achieve the most sufficient protection of the one-piece insert. All claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention. *See KSR International Co. v. Teleflex Inc.*, 550 U.S.____, 82 USPQ2d 1385 (2007).

Response to Arguments

9. Applicant's arguments have been fully considered, but they are not persuasive. Applicant has presented an extensive discussion (on p. 7-10 of the amendment) related to a method of the production of the one-piece fuse insert of the instant invention, but has presented only several lines (last paragraph on p. 10 and first four (4) lines on p. 11), directed to the actual traversal of the Examiner's rejection. The gist of said traversal is that, allegedly, "the difference over the prior art consists in that in the fuse insert of the invention, there takes place a stamping, not a milling or cutting. In the prior art, the fuse segment with the reduced thickness is manufactured in two steps, namely by punching or stamping, and by subsequent milling". Firstly, Examiner would like to remind Applicant that if the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. See *In re Thorpe*, *In re Brown*, and *In re Hirao and Sato, supra*. Secondly, it is not clear why Applicant contradicts himself by stating that in the prior art there is taking place "milling or cutting" and right next to it Applicant states that "[i]n the prior art, the fuse segment with the reduced thickness is manufactured in two steps, namely by punching or stamping, and by subsequent milling" (emphasis added). Examiner would like to direct the Applicant's attention to the fact that both Aryamane and Oh patents, teach the process of coining (please note that "coining" is a way of stamping / pressing) as the alternative and single process used to produce the area of the reduced thickness (e.g. see Oh, col. 2, lines 6-8, where is stated that "[t]here are two preferred ways that the fusible link may be made thinner than the terminals. The first is by a skiving process, and the second is by a coining process"

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(emphasis added)). And thirdly, even if to assume, *arguendo*, that two processes/steps have been disclosed as used together to produce the area of the reduced thickness (i.e. coining and milling / cutting), then the teaching of said “coining” is sufficient to meet the language of the claim. Claim 1 only recites that “the connection piece is pressed flat”. Whether the reference teaches additional steps, beyond said coining (stamping, pressing) is irrelevant. Claim 1 is broader than argued.

In view of the above, the rejection is hereby maintained.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANATOLY VORTMAN whose telephone number is (571)272-

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2047. The examiner can normally be reached on Monday-Thursday, between 10:00 am and 8:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Jayprakash Gandhi can be reached on 571-272-3740. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Anatoly Vortman/
Primary Examiner, Art Unit 2835